

REMARKS

In the Office Action, the Examiner rejected claims 1-30. Claims 1-30 remain pending in the present application. Applicant respectfully requests reconsideration and allowance of all pending claims.

First Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-27 as being unpatentable over the Van Boven et al. (hereinafter "Van Boven") reference, U.S. Pat. No. 5,807,052, in view of the Bernoni reference, U.S. Pat. No. 5,584,628. Applicant respectfully traverses the rejection.

In the Office Action, the Examiner stated the following:

Van Boven discloses a fastener assembly comprising a stemmed washer having a standoff portion (120) and a spring washer portion (124). The spring washer portion is formed at an acute angle relative to standoff portion and having a generally conical shape which is elastically deformable (Figs. 6a and 6b). Van Boven shows an externally threaded fastener retained to the stemmed washer but, does not disclose an internally threaded fastener. Bernoni discloses a fastener assembly wherein a fastener is retained to a washer and teaches to interchange an internally threaded fastener as seen in Fig. 5 for and (sic) externally threaded fastener as seen in Figs. 1 and 3. Accordingly, at the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Van Boven with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally treaded fastener. Bernoni further discloses the fastener to have a flange (not labeled) and the washer to have a retaining portion comprising a skirt deformed inwardly to capture the flange (at 14) such that the fastener is rotatable relative to the washer. At the time the invention was made, the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven. The method would have been inherent in the combination.

However, claims 1-27 are patentable because there is nothing in either the Van Boven or the Bernoni references that suggests the desirability, and thus the obviousness, of combining the references. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Van Boven sets forth an arrangement that *already retains* a fastener in a manner quite different from the structure claimed. Thus, the Van Boven reference does not need to be modified by Bernoni to retain the fastener. The Van Boven reference discloses a pre-assembled workpiece 100 that comprises a sleeve member 120 and a fastener member 110. *See* Van Boven, col. 2, lines 55-58. "The fastener member 110 has a threaded shank portion 112 and a head 114, and is *retainably* disposed through the sleeve member 120." Van Boven, col. 3, lines 58-60 (Emphasis added).

Thus, the motivation to combine the references provided by the Examiner is not supported by the prior art. As noted above, the Examiner stated in the Office Action that: "At the time the invention was made, the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven." However, since the Van Boven reference already discloses a means for retaining the fastener member 110 within the sleeve member 120, there is no reason to look to the Bernoni reference for a means of retaining the fastener 110.

Indeed, this combination would make the retaining features of Van Boven *entirely superfluous*, and *unworkable*. Specifically, the sleeve member 120 has a protuberance 122 that protrudes from an inner surface of the sleeve member 120. *See* Van Boven, col. 2, lines 52-56. The fastener 110 has a corresponding protruding shank member, or protuberance, 116 that is

located between the threaded end portion 112 and the head 114. *See* Van Boven, col. 4, lines 57-62. The radial surface 118 of the shank rib member 116 engages the radial surface 123 of the sleeve member 122 to prevent removal of the fastener 110 from the sleeve member 120 in one direction. *See* Van Boven, col. 2, lines 64-67. The flanged portion 115 of the head 114 engages the first end of the sleeve member 120 to prevent the fastener 110 from being inserted completely through the sleeve member 120 in the opposite direction. *See* Van Boven, col. 2, line 67-col. 3, line 2. Thus, the fastener 110 of Van Boven is retained within the sleeve member 120 without the need to look to the Bernoni reference for a means for retaining the fastener 110.

In conclusion, the cited references simply do not suggest the desirability of modifying Van Boven in view of Bernoni. In fact, using the method of Bernoni to retain the fastener 110 would render it unsatisfactory for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *See Also* MPEP § 2143.01, pg. 2100-127. In Bernoni, the head 13 of a bolt 11 is retained within an annular seat 14 (represented by the Examiner as a retaining skirt) of a bush 12. *See* Bernoni, Fig. 3. As a result, the annular seat 14 severely limits the axial movement of the head 13 of the bolt 11, and thus the bolt 11. *See* Bernoni, Fig. 3. Therefore, if the radial flange 124 of the sleeve member 120 of Van Boven was modified to retain the head 114 of the fastener 110 as per Bernoni, the axial movement of the fastener 110 relative to the sleeve member 120 would be severely limited.

On this precise point, the Van Boven reference states that:

According to this aspect of the invention, the fastener 110 is *axially* positionable relative to the first work piece so that the fastener 110 does not protrude beyond the mounting surface 106 of the first workpiece 101 during mounting and alignment. The fastener 110 is subsequently *axially* extendable into the bore 14 of

the second workpiece 10. (Van Boven, col. 5, lines 3-12).
(Emphasis added).

Thus, by retaining the head 114 of the fastener 110 of Van Boven as per Bernoni, the fastener 110 would not be axially positionable, and would therefore be rendered unsatisfactory for its intended purpose. Accordingly, at the time the invention was made, a person of ordinary skill in the art would not have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven.

For all of these reasons, claims 1-27 are patentable over the cited references. Withdrawal of the rejection and allowance of the pending claims are respectfully requested.

Second Rejection Under 35 U.S.C. § 103

Claims 28-30 are rejected under 35 U.S. C. 103(a) as being unpatentable over Van Boven in view of Bernoni and further in view of applicant's admitted prior art (APA). Applicant's respectfully traverse the rejection.

Claims 28-30 are patentable because there is no suggestion or motivation to combine the references. For all of the reasons provided above, there is no suggestion or motivation to combine the Van Boven and Bernoni references. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the Examiner is improperly relying on the applicant's disclosure to provide the motivation to combine.


For all of these reasons, claims 28-30 are patentable over the cited references. Withdrawal of the rejection and allowance of the pending claims are respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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